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The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 18

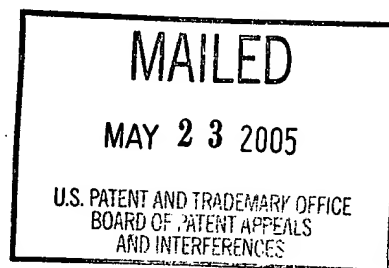
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. BOU AND JACK M. BAYT

Appeal No. 2005-0023
Application No. 09/585,508

ON BRIEF



Before JERRY SMITH, DIXON, and BLANKENSHIP, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-18,
which are all of the claims pending in this application.

We REVERSE.

Appellants' invention relates to a method and apparatus for inferred selection of objects. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A computer-implemented method for selecting objects comprising:
 - displaying a two-dimensional viewport of one or more existing objects maintained within a three-dimensional space represented in a computer-implemented graphics system;
 - obtaining a selection request from a user using a cursor selection device while locating the cursor in the two-dimensional viewport;
 - examining the existing objects to obtain one or more relationships between the existing objects;
 - creating one or more virtual objects that are not specifically stroked based on the relationships;
 - creating a selection set comprised of at least one of the existing objects and at least one of the virtual objects based on the relationships;
 - determining if the selection request is for an object in the selection set; and
 - if the selection request is for an object in the selection set, selecting all of the objects in the selection set.

The prior art of record relied upon by the examiner in rejecting the appealed claims are as follows:

Edwards et al. (Edwards)

6,459,442

Oct. 1, 2002
(filed Dec 1, 1999)

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Microsoft Windows 4.0 (service Pack 6, RC1.3; Licensed to the USPTO) screen dumps 1-7, Copyright 1998 (hereinafter referred to as "MS Win").

Claims 1-18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Edwards in view of MS Win.

Rather than reiterate the conflicting viewpoints advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 13, mailed Nov. 7, 2003) for the examiner's reasoning in support of the rejections, and to appellants' brief (Paper No. 12, filed Oct. 13, 2003) and reply brief (Paper No. 15, filed Jan 16, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a *prima facie* case of obviousness. **See In re Rijckaert**, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A *prima facie* case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See In re Lintner**, 458 F.2d

1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is *prima facie* obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See In re Fine**, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See **In re Warner**, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., Grain Processing Corp. v. American Maize-Prods. Co.**, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in art would lead that individual to combine the relevant teachings of the references.'" **In re Lee**,

277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing **In re Fritch**, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." **Dembiczak**, 175 F.3d at 999, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) .

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. "[T]he name of the game is the claim." **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations set forth in independent claim 1. We find that the language of independent claim 1 requires that there be both existing and virtual objects and that a relationship between two¹ existing objects be determined which is used to create the virtual object(s) and then the selection set.

Throughout the brief and reply brief, appellants take various reasoned interpretations of the examiner's sweeping rejection in an effort to rationalize a correspondence of the teachings of Edwards and MS Win to the invention as recited in

¹ While the language of independent claim 1 recites "one or more existing objects maintained within a three-dimensional space" we find that there must be at least two existing objects otherwise there can be no determination of any relationship.

independent claim 1. With each reasoned interpretation the combined teachings do not teach or fairly suggest the claimed invention. We generally agree with appellants' analysis. Additionally, we do not find that Edwards or MS Win teach or fairly suggest the creation of a virtual object, that not specifically stroked, based on a determined relationship from existing objects in a two dimensional representation of a three dimensional space. Moreover, we do not agree with the examiner's reliance on the icons (two dimensional) of MS Win as having a determined relationship and not being specifically stroked. We find that the users action to group these icons together is not a creation of virtual object based on a determined relationship between existing objects.

Further, we find that the examiner's attempts to reconstruct the claimed invention to be based upon impermissible hindsight. Therefore, we find that the examiner has not established a *prima facie* case of obviousness of the invention as recited in independent claim 1. Furthermore, even if combined, the teachings of Edwards and MS Win would not have taught or suggested the invention as recited in independent claim 1 and its respective dependent claims.

Similarly, we find that the above combination does not teach or suggest the invention as recited in independent claims 7 and 13 and their respective dependent claims.

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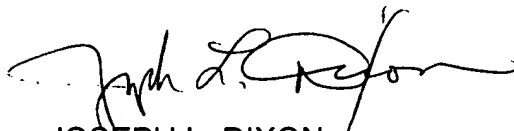
CONCLUSION

To summarize, the decision of the examiner to reject claims 1-18 under
35 U.S.C. § 103 is reversed.

REVERSED



JERRY SMITH
Administrative Patent Judge



JOSEPH L. DIXON
Administrative Patent Judge



HOWARD B. BLANKENSHIP
Administrative Patent Judge

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